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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/957,018	09/20/2001	Joseph E. Kaminkow	0112300-581	2458
29159	7590	05/22/2006	EXAMINER	
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			MCCULLOCH JR, WILLIAM H	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/957,018		KAMINKOW, JOSEPH E.	
	<b>Examiner</b>		<b>Art Unit</b>	
	William H. McCulloch Jr.		3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-12 and 14-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-12 and 14-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/24/05 + 5/4/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to amendments received 10/24/2005. The application has claims 1-4, 6-12, and 14-25 pending, with claims 1, 6, 8, 9, 14, 15, 16, 18, 21, 23, and 25 currently amended.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) with mailroom date 10/24/2005 was filed in compliance with the provisions of 37 CFR 1.97-1.98. Accordingly, the examiner has considered the information disclosure statement.

3. The IDS with mailroom date 5/4/2005 contained 4 documents that were distorted to the extent that examination of these documents was precluded. The following documents were not considered by the examiner: "Buck's Roulette", "Chariot's [sic] of Fortune", "Cyberdyne Gaming", and "Wheel of Fortune" pub. 1998. See attached form 1449.

#### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-4, 6-12, and 14-25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,599,185. The rejection set forth in a previous office action is maintained and incorporated herein.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-4, 6-12, and 14-25 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 6,173,955 to Perrie et al. (hereinafter Perrie).

Perrie teaches a method for playing a stand-alone and a bonus casino poker game using X number of dice, each die having F number of faces and a different symbol on each face to form a set S of symbols on each of the X dice (see at least the abstract and Summary of the Invention). Regarding claims 1 and 21, Perrie discloses the following features:

a. A display device (see at least figs. 3 and 5 and corresponding description);

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- b. A processor in communication with the display device (see at least 9:38-40);
- c. A plurality of selections adapted to be displayed to a player by the display device and a plurality of different values associated with the selections (dice with values on each face, see at least 3:40-5:9);
- d. At least one set of a plurality of said values determined and displayed by enabling the player to pick a plurality of said selections (dice rolls), wherein the plurality of values (faces) in the set (e.g. X=6 dice values) are based on the values associated with the selections picked by the player (see at least 3:60-5:9); and
- e. At least one award generated by the processor by selecting at least one but not all of the plurality of values of the set, wherein said award is provided to the player by the processor (e.g. an outcome of 3-of-a-Kind pays 4:1, see at least Table I).

Regarding claims 2, 20, and 22, Perrie teaches selecting at least the largest value of the set (e.g. one pair of sixes, where six is the largest value). See at least Table I.

Regarding claim 3, Perrie teaches selecting at least one but not all of the plurality of values (e.g. two pairs) and a resulting award is provided to the player generated by performing at least one mathematical operation on the awards from the sets (e.g. multiplication by 2). See at least Table I.

Regarding claim 4, Perrie teaches a plurality of sets (rolls) that each yield an award (e.g. the Payoff measured in coins) by selecting at least one but not all of the plurality of values of said set (e.g. 4-of-a-Kind) and a resulting award provided to the player by selecting at least one of the awards yielded from the plurality of sets (see at least 5:10-7:3).

Claim 6 is similar to claim 1 described above, with the exception of the number of sets of values. Regarding claim 6, Perrie teaches a plurality of sets of values (e.g.  $Y=2$  rolls of  $X=5$  dice, see at least Example II) and each of said sets is determined and displayed by enabling the player to pick a plurality of said selections. See at least 5:10-64. Claim 8 is rejected based upon the same example.

Regarding claim 7, Perrie shows revealing values associated with selections that are not picked by the player (see at least figs. 3 and 5).

Regarding claim 9, in addition to the features described above, Perrie teaches independent sets of dice rolls, wherein a plurality of awards is generated by selecting at least one but not all of the values selected (see at least "Leave Nothing to Chance" on 21:40-22:28). Regarding claim 10, the same example teaches selecting at least the largest value of at least one set when the largest value (e.g.  $F=6$ ) occurs. Regarding claims 11 and 12, the example teaches adding together the awards from each hand played. Claims 14 and 25 contain substantially similar subject matter as claims 9-12 and are rejected for the same reasons.

Regarding claim 15, Perrie teaches the elements described above and additionally teaches generating a resulting award by selecting at least one but not all of

a plurality of awards. As taught in Example II, a player may re-roll the dice in order to improve the payoff amount. Thus, if a player wishes to re-roll they will not be awarded the initially achieved payoff. When a subsequent roll is successful in producing a winning outcome, the player is awarded the subsequent payoff, and therefore at least one but not all awards are given to the player. See at least 5:10-7:13. Claims 18, 19, 23, and 24 are rejected for the same reasons.

Regarding claims 16 and 17, Perrie teaches elements described above and additionally teaches that the value of a hand may be calculated as the sum of the individual dice (see at least 4:36-39 and Examples I and II).

### ***Response to Arguments***

8. Applicant's arguments with respect to the rejection of claims 1-4, 6-12, and 14-25 under 35 U.S.C. 102 have been considered but are moot in view of the new ground(s) of rejection.

9. Applicant's arguments (see p.15-16 of "Remarks") filed 10/24/2005, with respect to claim objections have been fully considered and are persuasive. In view of both arguments and amendments, the objections to claims 6, 8, 9, 14, 15, 16, 18, and 19 are hereby withdrawn.

10. Applicant's arguments filed 10/24/2005 with regard to the rejection of claims under Obviousness-type double patenting have been fully considered but they are not persuasive. Applicant argues that U.S. 6,599,185 to Kaminkow et al. ('185) is not encompassed by claims of the instant invention because, in the instant claims, a player's pick of a selection is not associated with at least one award from each of a

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plurality of pools of awards. However, at least claims 6, 9, 14, and 25 recite generating a resulting award in a manner that is based upon a plurality of awards, which encompasses the subject matter claimed in '185 regarding a player's pick of a selection associated with at least one award from each of a plurality of pools of awards.

Furthermore, claim 29 of '185 recites a processor operable to:

“cause one of the selections from the group of selections to be picked, determine awards associated with the selection from the plurality of award pools for distribution to the picked selection by randomly determining a number of awards from each of the award pools to be assigned to said picked selection and randomly selecting the determined number of awards from each said award pool, distribute the determined awards to the picked selection, provide a player with the awards associated with the selection.”

Thus, '185 teaches determining a number of awards from each pool, which is encompassed by the language of the remaining instant claims: “at least one award,” or an award generated by “selecting at least one but not all of the plurality of awards”. Therefore, the rejection under Obviousness-type double patenting is deemed proper.

#### ***Citation of Pertinent Prior Art***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. 6,174,235 to Walker et al. shows a method and apparatus for directing a game with user-selected elements. U.S. 6,921,334 to Bennett shows a gaming machine with random selections. U.S. 5,205,555 to Hamano shows an electronic gaming device using mathematical operations to generate award outcomes.



***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

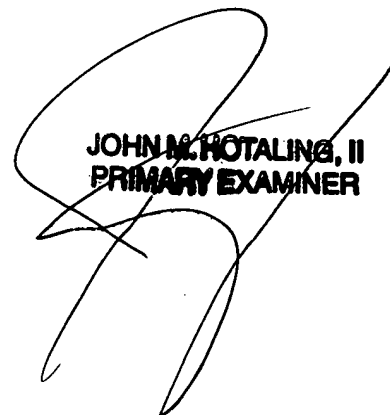
Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch Jr. whose telephone number is (571) 272-2818. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William H. McCulloch Jr.  
Examiner  
Art Unit 3714  
8/15/2006

wm

  
**JOHN M. ROTALING, II**  
**PRIMARY EXAMINER**